

### **REMARKS/ARGUMENTS**

This Response has not amended or added any claims. Consequently, it is believed that no additional claim fees have been generated by this filing. It is believed, however, that a one-month extension of time is required. A petition for a one-month extension of time accompanies this Response. If it is determined, however, that any additional fees are due in this application, the Commissioner is hereby authorized to charge Deposit Account No. 19-2260 in the amount of such fees.

Section 1 of the Office Action states that claim 16 was amended in the Response filed on October 28, 2004. The undersigned has reviewed the record, however, and it is believed that claim 16 was not amended in the October 28<sup>th</sup> Response.

Sections 2 and 3 of the Office Action reject the pending claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-72 of U.S. Patent No. 6,149,062. The Office Action states that the claims are not patentably distinct from each other. Applicants respectfully disagree with the rejection.

Applicants believe that the Examiner has not established a prima facie case of nonstatutory-type double patenting. At least three factors are required to establish such a case. First, the Examiner must identify the inventions claimed in the claims under consideration and in the patent claims. Second, the Examiner must establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person of ordinary skill in the

art. Third, the Examiner's showing of obviousness must follow the analysis used to establish a prima facie case of obviousness. The initial burden to establish such a case is on the Examiner. Further, the rejection must include clear evidence to establish why alleged variations of an invention claimed in a prior patent would have been obvious. A mere finding by an Examiner that the claims themselves are obvious variations is not legally sufficient.

The rejection recites the features of pending claim 16 and issued claims 1 and 72. First, it is not clear from the Office Action if the rejection is based separately on the content of claim 1, separately on the content of claim 72, or as a single rejection that is based on a combination of the two claims. If the rejection is based on a direct comparison of pending claim 1 and issued claim 16, Applicants hereby refer to the remarks presented in the Response filed on October 28, 2004.

If the rejection is also based on a comparison solely involving pending claim 16 and issued claim 72, Applicants note that there are several significant differences between claims 16 and 72 that are not addressed. For example, issued claim 72 states that the element characterized therein as a "base unit" is contained within the "detachable reader unit's" confines. By way of contrast, pending claim 16 specifies that the detachable portion containing the reader unit does not extend the width or length of the "data processing assembly." Thus, the pending claim presents a different situation. In claim 72, coupling the detachable reader unit with the base unit would serve to extend the dimensions of the base unit.

If the rejection is based on a comparison of pending claim 16 with a combination of features contained in issued claims 1 and 72, Applicants believe the rejection fails for a

variety of reasons. First, Applicants believe that the combining of two different claims having different scope is not permissible in establishing an obviousness-type double patenting rejection. In addition, even if such an approach is permissible, for the reasons expressed in the preceding two paragraphs, the combination of claims cited does not establish the rejection. Consequently, it is requested that the double-patenting rejection be withdrawn.

Sections 4 and 5 of the Office Action reject the pending claims under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 4,916,441 (Gombrich). The pending independent claims, however, are disclosed, for example, in the specification of ancestral parent application number 07/143,921. The January 14, 1988, filing date of U.S. application number 07/143,921 is ahead of the earliest referenced date (September 19, 1988) of the cited Gombrich patent. As requested by the Examiner, a copy of the 07/143,921 application, including the specification, claims and drawings, accompanies this Response.

Finally, the Applicants have previously elected the group including claims 16-29 and 37-44 with traverse. This was a provisional election of the type required by 37 CFR 1.143. Applicants have requested reconsideration and subsequent withdrawal of the restriction requirement. Further, a reminder of that traversal was included in the responses that were filed on March 24, 2004, and on October 28, 2004. Applicants hereby repeat their request that the restriction requirement be reconsidered and withdrawn.

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Amdt. dated May 16, 2005  
Office Action mailed Jan. 14, 2005

**PATENT APPLICATION**  
Attorney Docket No. 36767YBB

Applicants believe that the above remarks provide a complete response to the issues presented in the Office Action. Further, as a result of the demonstrated allowability of the claims, entry of a Notice of Allowance is respectfully requested.

Respectfully Submitted,

By



Michael F. Williams  
Reg. No. 39,875

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Simmons, Perrine, Albright & Ellwood, P.L.C.  
115 First Street SE, Suite 1200  
Cedar Rapids, IA 52401-1266  
Telephone: (319) 366-7641 (ext. 222)  
Facsimile No. (319) 366-1917